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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,813

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Daisuke Matsumoto

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EXAMINER

PANI, JOHN

ART UNIT

PAPER NUMBER

3736

MAIL DATE

DELIVERY MODE

11/24/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/538,813	<b>Applicant(s)</b> MATSUMOTO ET AL.	
	<b>Examiner</b> JOHN PANI	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,3,5-26 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,5-26 and 28-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/24/09</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 21 objected to because of the following informalities: The first line of the final paragraph appears to include an extraneous "that" prior to "is configured". It is suggested to delete said "that". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 29 and 30 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 29 and 30 recite the limitation "wherein the controller remains inactive until the height detector detects that the skin has been raised to the predetermined height inside the cylindrical portion". The original disclosure appears to be silent regarding activity of the controller prior to the height detector detecting that the skin has been raised to the predetermined height inside the cylindrical portion. Therefore, the original disclosure does not provide adequate support for the new limitation.

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4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3, 5-26, and 28-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In reference to Claims 1, 3, 5-20, 25, 28, and 29

Line 8 recites “the height detector detecting”. It is unclear whether the claim would be met by an apparatus with a height detector that was capable of “detecting that the skin has been raised to a predetermined height”, or whether the claim requires an apparatus that is currently in a state of “detecting”. This lack of clarity regarding the scope of the claim renders it indefinite. It is suggested to amend the claim to insert – configured for— prior to “detecting”.

Lines 13-14 recite “the control by the pressure controller being executed based on detection”. It is unclear whether the claim would be met by an apparatus with a pressure controller capable of/configured for/etc. executing a control based on detection, or whether the claim requires an apparatus that is currently in a state of executing. This lack of clarity regarding the scope of the claim renders it indefinite. It is suggested to amend the claim to replace “the control by the pressure controller being executed based on detection of” with –the pressure controller configured to execute the control based on detection by--.

Lines 15-16 recite “the specific range being defined by granting a specific tolerance to a reference pressure that is set....” It is unclear whether this limitation requires that some portion of the device is currently in the act of defining by granting, or whether the limitation would be met by a device which could merely be used in the claimed manner. Further, it is unclear which portion of the device, if any, is carrying out the various functions. If the claim is intended to suggest that the device is merely capable of this use, the claim terminology does not make this clear, as the cited limitation is essentially “tacked on” to the end of the claim without any words making clear how the phrase relates to the rest of the apparatus. In other words, the extent to which various abstract ideas such as “predetermined height”, “specific tolerance”, “reference pressure”, etc. are a part of the apparatus will remain unclear without somehow tying these ideas into the structure of the “pressure controller”. It is suggested to replace “the specific range being defined by granting a specific tolerance to a reference pressure that is set at a lower value” with --the pressure controller being configured to define the specific range by granting a specific tolerance to a reference pressure that the pressure controller is configured to set at a lower value--.

Claims 3, 5-20, 25, 28, and 29 are indefinite by virtue of depending from indefinite claim 1.

In reference to Claim 5

Line 2 recite “upper limit and a lower limit which are set”. It is suggested to replace “are” with --the pressure controller is configured to--, for reasons analogous to those stated above with respect to claim 1.

In reference to Claims 21

Line 16 recites "the specific range being defined by granting". It is suggested to replace "the specific range being defined by granting" with --the controller configured to define the specific range by granting-- for reasons analogous to those stated above with respect to claim 1.

Claims 22-24 are indefinite by virtue of depending from indefinite claim 21.

In reference to Claim 26

Lines 10-12 recite "a controller configured to cooperate with the height detector for executing a control so as to maintain a pressure inside the cylindrical portion within a specific range, the control being executed based on detection of the height detector". It is suggested to replace this limitation with --a controller configured to cooperate with the height detector, the controller configured to execute a control so as to maintain a pressure inside the cylindrical portion within a specific range, the controller configured to execute the control based on detection by the height detector--, for reasons analogous to those stated above with respect to claim 1.

Lines 14-15 recite "wherein the specific range is defined by granting a specific tolerance to a reference pressure which is set". It is suggested to replace this limitation with --wherein the controller is configured to define the specific range by granting a specific tolerance to a reference pressure which the controller sets--, for reasons analogous to those stated above with respect to claim 1.

Claim 30 is indefinite by virtue of depending from indefinite claim 26.

In reference to Claims 29 and 30

Lines 1-2 recite "the pressure controller remains inactive". It is unclear whether the claim requires that the invention be in a state of inactivity, or merely requires a device capable of this use. It is suggested to replace "remains inactive" with --is configured to remain inactive--.

### ***Allowable Subject Matter***

6. Claims 1, 21, and 26 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
7. Claim 5 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
8. Claims 3, 6-20, 22-25, and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN PANI whose telephone number is (571)270-1996. The examiner can normally be reached on Monday-Friday 7:30 am - 5:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JP 11/20/09

/Max Hindenburg/  
Supervisory Patent Examiner, Art Unit 3736